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10/723,151	11/26/2003	John Connelly	085804.013202	9218
76/58 7590 03/16/2011 YAHOO! INC. C/O GREENBERG TRAURIG, LLP MET LIFE BUILDING 200 PARK AVENUE NEW YORK, NY 10166				
EXAMINER GARTLAND, SCOTT D				
ART UNIT 3622		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mendozac@GTLAW.COM
NYIPMAIL@gtlaw.com
cordesp@gtlaw.com

Office Action Summary

Application No.

10/723,151

Applicant(s)

CONNELLY ET AL.

Examiner

SCOTT D. GARTLAND

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,6,8-31,33,35,36,38-43,45-48,50,53,54 and 56-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,6,8-31,33,35,36,38-43,45-48,50,53,54 and 56-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date 08-09-2010
- 4) ☐ Interview Summary (PTO-813)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 29, 2010 has been entered.

Status

2. This Office Action is in response to the communication filed on January 4, 2011. Claims 3-4, 7, 32, 34, 37, 44, 49, 51-52, and 55 have been cancelled currently or previously, claims 1, 9-11, 21-22, 24-25, 31, 45-46, 50, 56-58, and 62-64 have been amended, and no claims have been added. Therefore, claims 1-2, 5-6, 8-31, 33, 35-36, 38-43, 45-48, 50, 53-54, and 56-64 are pending and presented for examination.

Response to Amendment

3. A summary of the Response to Applicant's Amendments:
 - Applicant's amendment overcomes the objections to claims 37 and 55; therefore the Examiner withdraws the objections.

- Applicant's amendment does not overcome the rejections under 35 USC § 112, second paragraph, of claim 45; therefore the Examiner maintains the rejections as below. Please see the Response to Arguments below.
- Applicant's amendment overcomes the rejection(s) of claims 63-64 under 35 USC § 112, second paragraph; therefore the Examiner withdraws the rejection(s).
- Applicant's amendment does not overcome the rejections of claims 46-48, 50, 53-54, and 56-61 under 35 USC § 101; therefore the Examiner maintains the rejections.
- Applicant's amendment overcomes the rejection(s) of claims 62-64 under 35 USC § 101; therefore the Examiner withdraws the rejection(s).
- The Examiner notes new grounds of rejection under 35 USC §§ 102 and 103.
- Applicant's arguments are not persuasive, at least in part since moot; please see the Response to Arguments below.

Specification

4. **The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter.** See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Independent claims 1, 11, 25, 31, 45, and 46 contain the term "viewer demographics" at (at least) the amended portion at the end of each claim. This term is not contained in Applicant's description. Although the term is mentioned in original claims 4 and 52, there

appears to be no description indicating the gathering of viewer demographics, what demographics may be gathered, nor when, where, or how the demographic information may be gathered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 5. Claims 1-2, 5-6, 8-31, 33, 35-36, 38-43, 45-48, 50, 53-54, and 56-61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claims 1-2, 5-6, 8-20, 25-31, 33, 35-36, 38-43, 45-48, 50, 53-54, and 56-61 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. Independent claims 1, 11, 25, 31, 45, and 46 contain the term "viewer demographics" at (at least) the amended portion at the end of each claim; however, there is no indication of the viewer demographics ever being gathered. Therefore, the omitted steps are: the gathering (or similar terminology/concept) of viewer demographics. In order to match any data to viewer demographics, the viewer demographic information must be gathered or input to the system; therefore the Examiner understands that the gathering step is essential to operation of the

claimed methods and systems. The Examiner further notes the same reasoning and explanation may be applied to the matching of potential purchasers as indicated at claim 15. For examination purposes, the Examiner will interpret this to mean that viewer demographics are generated or input (by implication) based on a user search – the viewer being the user performing the search – such that the matching provides related search phrases.

Dependent claim 5 recites “the filtering criteria include search queries previously entered by users and the filtering includes discarding previously entered search queries”, where the Examiner is unsure which queries are used to filter and which are discarded. For examination purposes, the Examiner will interpret this to mean filtering according to any queries, such as related queries, and discarding any queries such as according to time constraints for relevancy.

Independent claim 21 recites the limitation “received user input” in the second element. There is insufficient antecedent basis for this limitation in the claim. The Examiner is uncertain if the received user input is the user queries received at the previous element or different inputs that appear to have no associated limitation. For examination purposes, the Examiner will interpret this to mean the user inputs are the user queries.

Claims 22-24 depend from claim 21 and does not resolve the above issues while inheriting the deficiencies of the parent claim; therefore, claims 22-24 are also indefinite.

Claims 27 and 28 recite the limitation "the visual display server" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 30 recites the limitation "display of data" in line 1. There is insufficient antecedent basis for this limitation in the claim.

The claim 45 elements of "receiving" and "selecting" are means (or step) plus function limitations that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function. The Examiner has searched Applicant's specification for a definition limiting the scope of the means for receiving, and notes that according to the specification, the means may be "via an on-line application" (paragraph 007), or via a web page and/or the internet (0036), which indicates that the "means for" may include software or a document (such as a web page), rather than a structural element or component. Furthermore, the means for selecting is described as being the Ad SWF (0082), which is identified as a type of file (0080). Since these elements are not defined as limited to structural components, the apparent limiting scope is outside the realm of a system.

Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

(a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

Independent claim 46 recites, at the second line of the first element, "the search queries are filtered..." and the Examiner is uncertain if this means the queries are

filtered when received, or if this means that Applicant is claiming the filtering as part of the method. Since the filtering is not indented as a separate step, and since grammatically the indication appears to explain the providing of the queries, the Examiner will, for purposes of examination, regard this to indicate the queries are filtered before they are received. As such, the Examiner notes that the filtering may be granted little if any patentable weight since performed separate from (prior to) the claimed method step(s).

Dependent claims 47-48, 50, 53-54, and 56-61 do not resolve the above issues and inherit the deficiencies of the parent claims; therefore claims 47-48, 50, 53-54, and 56-61 are also indefinite.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- 6. Claims 46-64 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claim 46 is drawn to a method comprising steps of providing a feed of queries, providing advertising, initiating display, and selecting demographic criteria. The providing and initiating are recited as performed by a computing device; however, these steps are similar (or analogous) to sending and receiving - actions that are

insignificant since performed by all general computers and a solution oriented step that would tie the method to a particular machine. The recited selecting step may represent significant activity, but is not positively recited as being performed by the computer. No physical transformation of matter is indicated or recited, either; therefore, since the method does not require a particular machine or the machine does not offer a meaningful limitation on the claim scope, nor does the claim physically transform matter, claim 46 is directed to nonstatutory subject matter.

Claims 47-48, 50, 53-54, and 56-61 depend from claim 46 and do not resolve this issue, and are therefore also directed to nonstatutory subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 62-64 are rejected under 35 U.S.C. 102(b) as being anticipated by Williams Jr. et al. (U.S. Patent No. 5,558,863, hereafter Williams).

Claim 62: Whitman discloses a system comprising:

a processor (see at least column:line 2:46-51; citation hereafter by number only);

and

a display (2:46-51, screen at which characters and symbols are to be displayed)

for displaying

a portion of an advertisement containing advertising content (little if any patentable weight may be granted to what is displayed on the computer since it does not patentably distinguish the computer itself, see MPEP § 2114), and

a portion of the advertisement containing search queries that have been filtered in accordance with predetermined filter criteria (little if any patentable weight may be granted to what is displayed on the computer since it does not patentably distinguish the computer itself, see MPEP § 2114).

Claim 63: Whitman discloses a computing device comprising:

a processor (2:46-51); and

a display (2:46-51, screen at which characters and symbols are to be displayed)

for displaying

predetermined perceptible information (little if any patentable weight may be granted to what is displayed on the computer since it does not patentably distinguish the computer itself, see MPEP § 2114); and

perceptible, changeable search queries that have been filtered in accordance with filter criteria, **wherein** the filter criteria is demographic criteria (little if any patentable weight may be granted to what is displayed on the computer since it does not patentably distinguish the computer itself, see MPEP § 2114).

Claim 64: Whitman discloses the computing device of claim 63, wherein the perceptible search queries change over time in accordance with predetermined change criteria (little if any patentable weight may be granted to what is displayed on the computer since it does not patentably distinguish the computer itself, see MPEP § 2114).

8. **Claims 21-23 and 62-64 are rejected under 35 U.S.C. 102(a) and (e) as being anticipated by Whitman et al. (U.S. Patent No. 6,772,150, hereafter Whitman).**

Please note that, as a convenience to applicant, the Examiner has pointed out, by **bolding**, optional or intended use language, and included a note as to the ramifications of such language below.

Claim 21: Whitman discloses a method for displaying data based on user input, the method comprising:

receiving, by a computing device, user queries from multiple users via an on-line help application (1:65-2:5, 3:39-41, 3:58-4:4, 5:44-64, where the Examiner notes that a search engine is a help application);

automatically selecting, by the computing device, received user input for display based on filtering criteria (1:65-2:5, 3:39-41, 3:58-4:4, 5:44-64); and

facilitating, by the computing device, display of data based on the selected user input to users (1:65-2:5, 3:39-41, 3:58-4:4, 5:44-64).

Claim 22: Whitman discloses the method of claim 21, wherein:

the selecting includes selecting received user input based on frequency of receipt (2:28-35, 3:39-44); and

the facilitating includes initiating display of a frequently received query and a response to the frequently received query to the users (3:64-67, 5:44-64, 13:59-14:22, Fig. 8).

Claim 23: Whitman discloses the method of claim 22, wherein the users are in communication via a network (4:34-43, Internet).

Claim 62: Whitman discloses a system comprising:

a processor (4:15-17, 4:45-49, computer and web server); and

a display (4:15-17, 4:45-49, computer and user computer, and 1:65-2:5, 3:39-41, 3:58-4:4, 5:44-64, indicating displaying) **for displaying**

a portion of an advertisement containing advertising content (13:59-14:22, Fig. 8, where the search results are understood to be advertisements), and

a portion of the advertisement containing search queries that have been filtered in accordance with predetermined filter criteria (13:59-14:22, Fig. 8).

Claim 63: Whitman discloses a computing device comprising:

a processor (4:15-17, 4:45-49, computer and web server); and

a display (4:15-17, 4:45-49, computer and user computer, and 1:65-2:5, 3:39-41, 3:58-4:4, 5:44-64, indicating displaying) **for displaying**

predetermined perceptible information (1:65-2:5, 3:39-41, 3:58-4:4, 5:44-64, where the Examiner notes that any information presented on a computer display is perceptible; the Examiner further notes that a computer is not patentably distinct based on the information it displays, therefore little if any patentable weight may be granted for this limitation); and

perceptible, changeable search queries that have been filtered in accordance with filter criteria (1:65-2:5, 3:39-41, 3:58-4:4, 5:44-64), **wherein** the filter criteria is demographic criteria (the Examiner notes the optional status of the wherein clause, whereby little if any patentable weight may be given the limitation; the Examiner further notes that a computer is not patentably distinct based on the information it displays, therefore little if any patentable weight may be granted for this limitation).

Claim 64: Whitman discloses the computing device of claim 63, wherein the perceptible search queries change over time in accordance with predetermined change criteria (1:65-2:5, 3:39-41, 3:58-4:4, 5:44-64; the Examiner further notes that a computer is not patentably distinct based on the information it displays, therefore little if any patentable weight may be granted for this limitation).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Whitman.

Claim 24: Whitman discloses the method of claim 21, but does not explicitly disclose wherein the selecting includes disregarding input received from a first user where the first user has previously entered the search query. Whitman, however, teaches the actions of others (claims 1 and 36) and prior users assisting the user by refining a searches (claims 1, 17, 36, and 43), that the daily transaction logs contain date, time, and user identification information (9:15-23), and that the frequency of

submission (2:28-35, 3:39-44). The Examiner understands that disregarding multiple inputs from a user is one of a limited number of predictable options available for reflecting popularity of search terms.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Whitman in order to disregard input from a first user where the first user has previously entered the search query or a similar search query.

The rationale for combining in this manner is that disregarding multiple inputs from a user is one of a limited number of predictable options available for reflecting popularity of search terms.

- 10. Claims 1-2, 5-6, 8-15, 17-18, 20, 25-27, 29-31, 33, 35-36, 38-41, 43, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitman in view of Kapur et al. (U.S. Patent No. 7,340,460, hereafter Kapur).**

Claim 1: Whitman discloses a method of providing a display, the method comprising:

receiving, by a computing device, search queries from multiple users (1:65-2:5, 2:13-16, 3:39-41, 3:58-4:4, 5:44-64), each search query in the search queries having associated demographic data (9:15-23, identity of the user, 2:28-35, 3:39-44, purchase events);

filtering, by the computing device, the search queries based on one or more filtering criteria (1:65-2:5, 3:39-41, 3:58-4:4, 5:44-64); and

selecting criteria to match viewer demographics of viewers of the filtered search queries, the filtering comprising identifying queries having information matching the viewer demographics, **thereby** initiating display of filtered search queries relevant to the viewers (1:65-2:5, 3:39-41, 3:58-4:4, 5:44-64, 6:22-25, 13:59-14:22).

Whitman, however, does not explicitly disclose the filtering criteria including demographic criteria, the filtering comprising identifying queries having demographic information matching the demographic criteria, and that the selecting criteria are demographic criteria. Where Whitman teaches demographic criteria (9:15-23, identity of the user, 2:28-35, 3:39-44, purchase events), and using the purchase events as criteria to rate, select, and present search queries as indicated by the recitations above, the Examiner understands Applicant to concentrate on demographics such as location or user input data; therefore this rejection is made under 35 USC § 103 in order to better reflect the state of the art and further prosecution. Whitman further teaches the criteria for selection may be any event that can be identified within a transaction log (5:44-64) and the transaction log including a user identification (9:15-23), where the Examiner further understands that, in order to return search results to a searcher, an address (e.g. IP address) for returning the information must be identified. Kapur further teaches grouping, binning, or otherwise associating previously submitted queries according to different criteria, including demographics, so as to develop or generate a histogram vector to represent query context (2:56-61, 11:53-12:5). The Examiner understands that it would be common sense to filter search queries presented to a user according to

demographic criteria since persons searching in regards to a particular location would expect other relevant searches to be filtered according to the location – e.g. a person in New York searching for a New York restaurant (or a restaurant in general) would not likely expect or desire search terms related to a California restaurant.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the refined search queries of Whitman with the demographic filtering of Kapur in order to filter search queries presented to a user according to demographic criteria.

The rationale for combining in this manner is that it would be common sense to filter search queries presented to a user according to demographic criteria as explained above.

Claim 2: Whitman in view of Kapur discloses the method of claim 1, where Whitman further discloses wherein the filtering criteria include words (1:65-2:5, 3:39-41, 3:58-4:4, 5:44-64).

Claim 5: Whitman in view of Kapur discloses the method of claim 1, where Whitman further discloses wherein the filtering criteria include search queries previously entered by users and the filtering includes discarding previously entered search queries (1:65-2:5, 2:13-20, 3:39-41, 3:58-4:4, 5:44-64, 12:8-19).

Claim 6: Whitman in view of Kapur discloses the method of claim 1, where Whitman further discloses wherein the filtering criteria include a number of times a search query is presented (2:28-35, 3:39-44).

Claim 8: Whitman in view of Kapur discloses the method of claim 1, where Whitman further discloses wherein initiating the display includes initiating display of filtered search queries to viewers at an event (5:44-64, holidays or Olympics, where the event may be any occurrence such as viewing a holiday event or the Olympics on TV or the Internet).

Claim 9: Whitman in view of Kapur discloses the method of claim 6, where Whitman further discloses wherein the filtering criteria include a certain website and a number of times a search query is presented, the filtering including identifying search results received via the certain website (1:65-2:5, 3:39-41, 3:58-4:4, 5:20-64).

Claim 10: Whitman in view of Kapur discloses the method of claim 6, wherein the filtering criteria include demographic criteria and a number of times a search query is presented, the filtering including identifying search queries received from users having demographics matching the demographic criteria (Whitman at 1:65-2:5, 3:39-41, 3:58-4:4, 5:44-64, and Kapur at 2:56-61, 11:53-12:5, as combined above, where the vectoring of Kapur is further understood to change according to the number of times presented and matched).

Claim 11: Whitman discloses a method of providing a display of information on a web page, the method comprising:

receiving, by a computing device, search queries from multiple users (1:65-2:5, 3:39-41, 3:58-4:4, 5:44-64), each search query in the search queries has associated demographic data (9:15-23, identity of the user, 2:28-35, 3:39-44, purchase events);

filtering, by the computing device, the search queries based on filtering criteria (1:65-2:5, 3:39-41, 3:58-4:4, 5:44-64); and

selecting criteria to match viewer demographics of viewers of the filtered search queries, the filtering comprising identifying queries having information matching the viewer demographics, **thereby** initiating display of filtered search queries relevant to the viewers (1:65-2:5, 3:39-41, 3:58-4:4, 5:44-64, 6:22-25, 13:59-14:22).

Whitman, however, does not explicitly disclose the filtering criteria including demographic criteria, the filtering comprising identifying queries having demographic information matching the demographic criteria, and that the selecting criteria are demographic criteria. Where Whitman teaches demographic criteria (9:15-23, identity of the user, 2:28-35, 3:39-44, purchase events), and using the purchase events as criteria to rate, select, and present search queries as indicated by the recitations above, the Examiner understands Applicant to concentrate on demographics such as location or user input data; therefore this rejection is made under 35 USC § 103 in order to better reflect the state of the art and further prosecution. Whitman further teaches the criteria for selection may be any event

that can be identified within a transaction log (5:44-64) and the transaction log including a user identification (9:15-23), where the Examiner further understands that, in order to return search results to a searcher, an address (e.g. IP address) for returning the information must be identified. Kapur further teaches grouping, binning, or otherwise associating previously submitted queries according to different criteria, including demographics, so as to develop or generate a histogram vector to represent query context (2:56-61, 11:53-12:5). The Examiner understands that it would be common sense to filter search queries presented to a user according to demographic criteria since persons searching in regards to a particular location would expect other relevant searches to be filtered according to the location – e.g. a person in New York searching for a New York restaurant (or a restaurant in general) would not likely expect or desire search terms related to a California restaurant.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the refined search queries of Whitman with the demographic filtering of Kapur in order to filter search queries presented to a user according to demographic criteria.

The rationale for combining in this manner is that it would be common sense to filter search queries presented to a user according to demographic criteria as explained above.

Claim 12: Whitman in view of Kapur discloses the method of claim 11, where Whitman further discloses wherein the display is an advertisement including display

of said filtered search queries (3:58-4:4, 5:44-64, 13:59-14:22, Fig. 8, where the search results are understood to be advertisements to use that term or go to that related content, especially since purchase events may occur as a result; the Examiner notes that what data is displayed – if the display were required – within an advertisement is descriptive material that may be granted little or no patentable weight).

Claim 13: Whitman in view of Kapur discloses the method of claim 12, where Whitman further discloses wherein the advertisement is on behalf of an advertiser, the method further comprising receiving filtering criteria from the advertiser (3:58-4:4, 5:44-64, 13:59-14:22, Fig. 8, where the search results are understood to be advertisements to use that term or go to that related content, especially since purchase events may occur as a result, and on the behalf of an advertiser; the Examiner understands, as one example for the Whitman reference, that the web site in Whitman is Amazon.com, where the "advertisement", then, is Amazon's site encouraging people to use their services – just as most e-commerce sites are advertisements to transact at the respective site - as such, the filtering criteria is the matching criteria and provided by the Advertiser, Amazon).

Claim 14: Whitman in view of Kapur discloses a method of claim 12, where Whitman further discloses wherein the advertisement is for a product and the

filtering criteria include an association between the product and search queries (6:1-15).

Claim 15: Whitman in view of Kapur discloses a method of claim 12, wherein the advertisement is for a product, the search queries have associated demographic information based on the users from which they are received and the filtering criteria include demographic criteria, the demographic criteria matching potential purchasers of the product (Whitman at 1:65-2:5, 3:39-41, 3:58-4:4, 5:44-64, and Kapur at 2:56-61, 11:53-12:5, as combined above).

Claim 17: Whitman in view of Kapur discloses the method of claim 11, where Whitman further discloses wherein display of filtered search queries includes display of a filtered search query link, activation of which initiates display of search results corresponding to the filtered search query link (13:59-14:22).

Claim 18: Whitman in view of Kapur discloses the method of claim 17, where Whitman further discloses wherein initiating display of the filtered search queries includes facilitating display of an advertisement and wherein activation of the link further includes display of advertising content (13:59-14:22).

Claim 20: Whitman discloses the method of claim 12, wherein the advertisement further includes a search toolbar (Figs. 2 and 8, top).

Claim 25: Whitman discloses a system comprising:

a first server communicatively coupled to a user interface, the first server selecting received user input **for display** based on first filtering criteria (1:65-2:5, 3:39-41, 3:58-4:4, 5:44-64), the user input having associated demographic data (9:15-23, identity of the user, 2:28-35, 3:39-44, purchase events);

the first server selecting criteria to match viewer demographics of viewers of the filtered user input, the filtering comprising identifying user input having information matching the viewer demographics, **thereby** initiating display by a visual display server of filtered user input relevant to the viewers (1:65-2:5, 3:39-41, 3:58-4:4, 5:44-64, 6:22-25, 13:59-14:22)

Whitman, however, does not explicitly disclose the filtering criteria including demographic criteria, the filtering comprising identifying queries having demographic information matching the demographic criteria, and that the selecting criteria are demographic criteria. Where Whitman teaches demographic criteria (9:15-23, identity of the user, 2:28-35, 3:39-44, purchase events), and using the purchase events as criteria to rate, select, and present search queries as indicated by the recitations above, the Examiner understands Applicant to concentrate on demographics such as location or user input data; therefore this rejection is made under 35 USC § 103 in order to better reflect the state of the art and further prosecution. Whitman further teaches the criteria for selection may be any event that can be identified within a transaction log (5:44-64) and the transaction log

including a user identification (9:15-23), where the Examiner further understands that, in order to return search results to a searcher, an address (e.g. IP address) for returning the information must be identified. Kapur further teaches grouping, binning, or otherwise associating previously submitted queries according to different criteria, including demographics, so as to develop or generate a histogram vector to represent query context (2:56-61, 11:53-12:5). The Examiner understands that it would be common sense to filter search queries presented to a user according to demographic criteria since persons searching in regards to a particular location would expect other relevant searches to be filtered according to the location – e.g. a person in New York searching for a New York restaurant (or a restaurant in general) would not likely expect or desire search terms related to a California restaurant.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the refined search queries of Whitman with the demographic filtering of Kapur in order to filter search queries presented to a user according to demographic criteria.

The rationale for combining in this manner is that it would be common sense to filter search queries presented to a user according to demographic criteria as explained above.

Claim 26: Whitman in view of Kapur discloses the system of claim 25, where Whitman further discloses further comprising:

a second server communicatively coupled to the first server, the second server selecting received user input for display based on second filtering criteria (4:45-64, 6:13-40, Fig. 1, web server 131 and query server 132).

Claim 27: Whitman in view of Kapur discloses the system of claim 25, where Whitman further discloses wherein the visual display server initiates display of user input via a web page (1:65-2:5, 3:39-41, 3:58-4:4, 5:44-64).

Claim 29: Whitman in view of Kapur discloses the system of claim 25, where Whitman further discloses wherein the user input is search queries (1:65-2:5, 3:39-41, 3:58-4:4, 5:44-64).

Claim 30: Whitman in view of Kapur discloses the system of claim 25, where Whitman further discloses wherein the display of data is display of an advertisement (3:58-4:4, 5:44-64, 13:59-14:22, Fig. 8, where the search results are understood to be advertisements to use that term or go to that related content, especially since purchase events may occur as a result).

Claim 31: Whitman discloses a system comprising:
one or more processors (4:15-17, 4:45-49, computer and web server) for:
receiving user input from multiple users via a network the user input being one or more search queries (1:65-2:5, 3:39-41, 3:58-4:4, 5:44-64) and the search queries

having associated demographic information (9:15-23, identity of the user, 2:28-35, 3:39-44, purchase events);

selecting received user input **for display** based on one or more filtering criteria (1:65-2:5, 3:39-41, 3:58-4:4, 5:44-64),;

selecting criteria to match viewer demographics of viewers of the filtered search queries, the filtering comprising identifying queries having information matching the viewer demographics, **thereby** initiating display of filtered search queries relevant to the viewers (1:65-2:5, 3:39-41, 3:58-4:4, 5:44-64, 6:22-25, 13:59-14:22).

Whitman, however, does not explicitly disclose the filtering criteria including demographic criteria, the filtering comprising identifying queries having demographic information matching the demographic criteria, and that the selecting criteria are demographic criteria. Where Whitman teaches demographic criteria (9:15-23, identity of the user, 2:28-35, 3:39-44, purchase events), and using the purchase events as criteria to rate, select, and present search queries as indicated by the recitations above, the Examiner understands Applicant to concentrate on demographics such as location or user input data; therefore this rejection is made under 35 USC § 103 in order to better reflect the state of the art and further prosecution. Whitman further teaches the criteria for selection may be any event that can be identified within a transaction log (5:44-64) and the transaction log including a user identification (9:15-23), where the Examiner further understands that, in order to return search results to a searcher, an address (e.g. IP address) for returning the information must be identified. Kapur further teaches grouping,

binning, or otherwise associating previously submitted queries according to different criteria, including demographics, so as to develop or generate a histogram vector to represent query context (2:56-61, 11:53-12:5). The Examiner understands that it would be common sense to filter search queries presented to a user according to demographic criteria since persons searching in regards to a particular location would expect other relevant searches to be filtered according to the location – e.g. a person in New York searching for a New York restaurant (or a restaurant in general) would not likely expect or desire search terms related to a California restaurant.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the refined search queries of Whitman with the demographic filtering of Kapur in order to filter search queries presented to a user according to demographic criteria.

The rationale for combining in this manner is that it would be common sense to filter search queries presented to a user according to demographic criteria as explained above.

Claim 33: Whitman in view of Kapur discloses the system of claim 31, where Whitman further discloses wherein the one or more filtering criteria include words (1:65-2:5, 3:39-41, 3:58-4:4, 5:44-64).

Claim 35: Whitman in view of Kapur discloses the system of claim 32, where Whitman further discloses wherein the filtering criteria include search queries

previously entered by users and the one or more processors are configured to discard previously entered search queries (1:65-2:5, 2:13-20, 3:39-41, 3:58-4:4, 5:44-64, 12:8-19).

Claim 36: Whitman in view of Kapur discloses the system of claim 31, where Whitman further discloses wherein the one or more filtering criteria include number of times a search query is received (2:28-35, 3:39-44).

Claim 38: Whitman in view of Kapur discloses the system of claim 36, where Whitman further discloses wherein the one or more processors are configured to facilitate display of selected search queries to viewers at an event (5:44-64, holidays or Olympics, where the event may be any occurrence such as viewing a holiday event or the Olympics on TV or the Internet).

Claim 39: Whitman in view of Kapur discloses the system of claim 36, where Whitman further discloses wherein the filtering criteria include a certain website and number of times a search query is received, the one or more processors configured to identify relatively popular search results received via the certain website (1:65-2:5, 3:39-41, 3:58-4:4, 5:20-64).

Claim 40: Whitman in view of Kapur discloses the system of claim 36, wherein the one or more filtering criteria include demographic criteria and a number of times

a search query is presented, the one or more processors configured to identify relatively popular search queries received from users having demographics matching the demographic criteria (Whitman at 1:65-2:5, 3:39-41, 3:58-4:4, 5:44-64, and Kapur at 2:56-61, 11:53-12:5, as combined above, where the vectoring of Kapur is further understood to change according to the number of times presented and matched).

Claim 41: Whitman in view of Kapur discloses the system of claim 36, where Whitman further discloses wherein the one or more processors are **configured to** facilitate display of selected search queries in an advertisement on a web site (3:58-4:4, 5:44-64, 13:59-14:22, Fig. 8, where the search results are understood to be advertisements to use that term or go to that related content, especially since purchase events may occur as a result; the Examiner notes that what data is displayed – if the display were required – within an advertisement is descriptive material that may be granted little or no patentable weight).

Claim 43: Whitman in view of Kapur discloses the system of claim 42, where Whitman further discloses wherein the one or more processors are configured to facilitate display of one or more selected search query links, activation of which initiates display of search results corresponding to the activated filtered search query link (13:59-14:22).

Claim 45: Whitman discloses a system comprising:

a computing device (4:15-17, 4:45-49, computer and web server) comprising:

means for receiving user input from multiple users via a network (1:65-2:5, 3:39-41, 3:58-4:4, 5:44-64) the user input associated with demographic information (9:15-23, identity of the user, 2:28-35, 3:39-44, purchase events);

means for selecting received user input for display based on one or more filtering criteria (1:65-2:5, 3:39-41, 3:58-4:4, 5:44-64); and

means for selecting criteria to match viewer demographics of viewers of the filtered user input, the filtering comprising identifying queries having information matching the viewer demographics, **thereby** initiating display of filtered user input relevant to the viewers (1:65-2:5, 3:39-41, 3:58-4:4, 5:44-64, 6:22-25, 13:59-14:22).

Whitman, however, does not explicitly disclose the filtering criteria including demographic criteria, the filtering comprising identifying queries having demographic information matching the demographic criteria, and that the selecting criteria are demographic criteria. Where Whitman teaches demographic criteria (9:15-23, identity of the user, 2:28-35, 3:39-44, purchase events), and using the purchase events as criteria to rate, select, and present search queries as indicated by the recitations above, the Examiner understands Applicant to concentrate on demographics such as location or user input data; therefore this rejection is made under 35 USC § 103 in order to better reflect the state of the art and further prosecution. Whitman further teaches the criteria for selection may be any event that can be identified within a transaction log (5:44-64) and the transaction log

including a user identification (9:15-23), where the Examiner further understands that, in order to return search results to a searcher, an address (e.g. IP address) for returning the information must be identified. Kapur further teaches grouping, binning, or otherwise associating previously submitted queries according to different criteria, including demographics, so as to develop or generate a histogram vector to represent query context (2:56-61, 11:53-12:5). The Examiner understands that it would be common sense to filter search queries presented to a user according to demographic criteria since persons searching in regards to a particular location would expect other relevant searches to be filtered according to the location – e.g. a person in New York searching for a New York restaurant (or a restaurant in general) would not likely expect or desire search terms related to a California restaurant.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the refined search queries of Whitman with the demographic filtering of Kapur in order to filter search queries presented to a user according to demographic criteria.

The rationale for combining in this manner is that it would be common sense to filter search queries presented to a user according to demographic criteria as explained above.

- 11. Claims 16, 19, 28, 42, 46-48, 50, 53-54, and 56-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitman in view of Kapur and in**

further view of Chane et al. (U.S. Patent Application Publication No. 2003/0084449, hereafter Chane).

Claim 16: Whitman in view of Kapur discloses the method of claim 12, wherein the advertisement includes a list of filtered search queries (3:58-4:4, 5:44-64, 13:59-14:22, Fig. 8, where the search results are understood to be advertisements to use that term or go to that related content, especially since purchase events may occur as a result; the Examiner notes that what data is displayed – if the display were required – within an advertisement is descriptive material that may be granted little or no patentable weight); however, Whitman in view of Kapur does not explicitly disclose that the list is a scrolling list. Chane, however, teaches displaying advertisements in a rotating or ticker fashion (paragraph 0012; citation hereafter by number only) and in an XML document (0096). The Examiner understands that a scrolling ticker and an XML document are each one of a limited number of predictable options available for forms of advertisement displays. The Examiner understands that the combining of Chane, since only related to the form of presentation, does not modify or alter the combining of Whitman and Kapur.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the refined search queries of Whitman with the demographic filtering of Kapur and the ticker and XML presentation of Chane in order to filter search queries presented to a user according to demographic criteria and to present the queries in a scrolling ticker advertisement.

The rationale for combining in this manner is that it would be common sense to filter search queries presented to a user according to demographic criteria as explained above and a scrolling ticker is one of a limited number of predictable options available for forms of advertisements for displaying search queries.

Claim 19: Whitman in view of Kapur discloses the method of claim 11, but does not explicitly disclose wherein facilitating display of the filtered search queries includes initiating a Flash movie. Chane, however, teaches displaying advertisements in a rotating or ticker fashion (paragraph 0012; citation hereafter by number only) and in an XML document (0096). The Examiner understands that a scrolling ticker, an XML document, and a Flash movie clip are each one of a limited number of predictable options available for forms of advertisement displays. The Examiner understands that the combining of Chane, since only related to the form of presentation, does not modify or alter the combining of Whitman and Kapur.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the refined search queries of Whitman with the demographic filtering of Kapur and the ticker and XML presentation of Chane in order to filter search queries presented to a user according to demographic criteria and to present the queries in a Flash movie clip.

The rationale for combining in this manner is that it would be common sense to filter search queries presented to a user according to demographic criteria as

explained above and a scrolling ticker is one of a limited number of predictable options available for forms of advertisements for displaying search queries.

Claim 28: Whitman in view of Kapur discloses the system of claim 25, but does not explicitly disclose wherein the visual display server initiates display of user input via a Flash movie. Chane, however, teaches displaying advertisements in a rotating or ticker fashion (paragraph 0012; citation hereafter by number only) and in an XML document (0096). The Examiner understands that a scrolling ticker, an XML document, and a Flash movie clip are each one of a limited number of predictable options available for forms of advertisement displays. The Examiner understands that the combining of Chane, since only related to the form of presentation, does not modify or alter the combining of Whitman and Kapur.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the refined search queries of Whitman with the demographic filtering of Kapur and the ticker and XML presentation of Chane in order to filter search queries presented to a user according to demographic criteria and to present the queries in a Flash movie clip.

The rationale for combining in this manner is that it would be common sense to filter search queries presented to a user according to demographic criteria as explained above and a scrolling ticker is one of a limited number of predictable options available for forms of advertisements for displaying search queries.

Claim 42: Whitman in view of Kapur discloses the system of claim 41, where Whitman further discloses wherein the advertisement includes a list of selected search queries (3:58-4:4, 5:44-64, 13:59-14:22, Fig. 8, where the search results are understood to be advertisements to use that term or go to that related content, especially since purchase events may occur as a result; the Examiner notes that what data is displayed – if the display were required – within an advertisement is descriptive material that may be granted little or no patentable weight); however, Whitman in view of Kapur does not explicitly disclose that the list is a scrolling list. Chane, however, teaches displaying advertisements in a rotating or ticker fashion (paragraph 0012; citation hereafter by number only) and in an XML document (0096). The Examiner understands that a scrolling ticker and an XML document are each one of a limited number of predictable options available for forms of advertisement displays. The Examiner understands that the combining of Chane, since only related to the form of presentation, does not modify or alter the combining of Whitman and Kapur.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the refined search queries of Whitman with the demographic filtering of Kapur and the ticker and XML presentation of Chane in order to filter search queries presented to a user according to demographic criteria and to present the queries in a scrolling ticker advertisement.

The rationale for combining in this manner is that it would be common sense to filter search queries presented to a user according to demographic criteria as

explained above and a scrolling ticker is one of a limited number of predictable options available for forms of advertisements for displaying search queries.

Claim 46: Whitman discloses a method of providing an advertisement, the method comprising:

providing, by a computing device, a feed of search queries, the search queries received from users (1:65-2:5, 3:39-41, 3:58-4:4, 5:44-64) and having associated demographic information (9:15-23, identity of the user, 2:28-35, 3:39-44, purchase events), the search queries are filtered in accordance with one or more filtering criteria (1:65-2:5, 3:39-41, 3:58-4:4, 5:44-64),;

providing, by the computing device, advertising content;

initiating, by the computing device, display of the advertisement, by the computing device, the advertisement comprising search queries of the feed and the advertising content; and

selecting criteria to match viewer demographics of viewers of the filtered search queries, the filtering comprising identifying queries having information matching the viewer demographics, **thereby** initiating display of filtered search queries relevant to the viewers (1:65-2:5, 3:39-41, 3:58-4:4, 5:44-64, 6:22-25, 13:59-14:22).

Whitman, however, does not explicitly disclose that the queries are in the form of a scrolling ticker of search queries the filtering criteria including demographic criteria, the filtering comprising identifying queries having demographic information matching the demographic criteria, and that the selecting criteria are demographic criteria.

Where Whitman teaches demographic criteria (9:15-23, identity of the user, 2:28-35, 3:39-44, purchase events), and using the purchase events as criteria to rate, select, and present search queries as indicated by the recitations above, the Examiner understands Applicant to concentrate on demographics such as location or user input data; therefore this rejection is made under 35 USC § 103 in order to better reflect the state of the art and further prosecution. Whitman further teaches the criteria for selection may be any event that can be identified within a transaction log (5:44-64) and the transaction log including a user identification (9:15-23), where the Examiner further understands that, in order to return search results to a searcher, an address (e.g. IP address) for returning the information must be identified. Kapur further teaches grouping, binning, or otherwise associating previously submitted queries according to different criteria, including demographics, so as to develop or generate a histogram vector to represent query context (2:56-61, 11:53-12:5). The Examiner understands that it would be common sense to filter search queries presented to a user according to demographic criteria since persons searching in regards to a particular location would expect other relevant searches to be filtered according to the location – e.g. a person in New York searching for a New York restaurant (or a restaurant in general) would not likely expect or desire search terms related to a California restaurant.

Whitman in view of Kapur, however, does not explicitly disclose that the queries are in the form of a scrolling ticker of search queries. Chane, however, teaches displaying advertisements in a rotating or ticker fashion (paragraph 0012; citation

hereafter by number only) and in an XML document (0096). The Examiner understands that a scrolling ticker and an XML document are each one of a limited number of predictable options available for forms of advertisement displays. The Examiner understands that the combining of Chane, since only related to the form of presentation, does not modify or alter the combining of Whitman and Kapur.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the refined search queries of Whitman with the demographic filtering of Kapur and the ticker and XML presentation of Chane in order to filter search queries presented to a user according to demographic criteria and to present the queries in a scrolling ticker advertisement.

The rationale for combining in this manner is that it would be common sense to filter search queries presented to a user according to demographic criteria as explained above and a scrolling ticker is one of a limited number of predictable options available for forms of advertisements for displaying search queries.

Claim 47: Whitman in view of Kapur and in further view of Chane further discloses the method of claim 46, where Chane further discloses wherein the feed is an XML document (0096).

Claim 48: Whitman in view of Kapur and in further view of Chane discloses the method of claim 46, where Whitman further discloses wherein the feed is provided in near real time after receiving the search queries (8:54-58).

Claim 50: Whitman in view of Kapur and in further view of Chane further discloses the method of claim 46, where Whitman further discloses wherein the filtering criteria include words (1:65-2:5, 3:39-41, 3:58-4:4, 5:44-64).

Claim 53: Whitman in view of Kapur and in further view of Chane further discloses the method of claim 46, where Whitman further discloses wherein the filtering criteria include search queries previously entered by users and the filtering includes discarding previously entered search queries (1:65-2:5, 2:13-20, 3:39-41, 3:58-4:4, 5:44-64, 12:8-19).

Claim 54: Whitman in view of Kapur and in further view of Chane further discloses the method of claim 46, where Whitman further discloses wherein the filtering criteria include a number of times a search query is presented (2:28-35, 3:39-44).

Claim 56: Whitman in view of Kapur and in further view of Chane further discloses the method of claim 46, where Whitman further discloses wherein initiating the display includes initiating display of filtered search queries to viewers at an event (5:44-64, holidays or Olympics, where the event may be any occurrence such as viewing a holiday event or the Olympics on TV or the Internet).

Claim 57: Whitman in view of Kapur and in further view of Chane further discloses the method of claim 54, where Whitman further discloses wherein the filtering criteria include a certain website and a number of times a search query is presented, the filtering including identifying search results received via the certain website (1:65-2:5, 3:39-41, 3:58-4:4, 5:20-64).

Claim 58: Whitman in view of Kapur and in further view of Chane further discloses the method of claim 54, where Whitman further discloses wherein the filtering criteria include demographic criteria and a number of times a search query is presented, the filtering including identifying search queries received from users having demographics matching the demographic criteria (Whitman at 1:65-2:5, 3:39-41, 3:58-4:4, 5:44-64, and Kapur at 2:56-61, 11:53-12:5, as combined above, where the vectoring of Kapur is further understood to change according to the number of times presented and matched).

Claim 59: Whitman in view of Kapur and in further view of Chane discloses the method of claim 46, but does not explicitly disclose wherein initiating the display includes incorporating the search queries into a Flash movie clip. Chane, however, teaches displaying advertisements in a rotating or ticker fashion (paragraph 0012; citation hereafter by number only) and in an XML document (0096). The Examiner understands that a scrolling ticker, an XML document, and a Flash movie clip are each one of a limited number of predictable options available for forms of

advertisement displays. The Examiner understands that the combining of Chane, since only related to the form of presentation, does not modify or alter the combining of Whitman and Kapur.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the refined search queries of Whitman with the demographic filtering of Kapur and the ticker and XML presentation of Chane in order to filter search queries presented to a user according to demographic criteria and to present the queries in a Flash movie clip.

The rationale for combining in this manner is that it would be common sense to filter search queries presented to a user according to demographic criteria as explained above and a scrolling ticker is one of a limited number of predictable options available for forms of advertisements for displaying search queries.

Claim 60: Whitman in view of Kapur and in further view of Chane further discloses the method of claim 46, where Chane further discloses the scrolling ticker (0012) and Whitman further discloses the search queries includes one or more links associated with one or more search queries, respectively, wherein each link is to search results corresponding to the associated search query (13:59-14:22).

- 12. Claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over Whitman in view of Kapur, in further view of Chane, and in further view of Croy (U.S. Patent Application Publication No. 2001/0037361).**

Claim 61: Whitman in view of Kapur and in further view of Chane further discloses the method of claim 46, but does not explicitly disclose wherein initiating display of the advertisement includes initiating inclusion of a search window **for receiving** a new search query in the advertisement. As with Chane, the Examiner understands that including a search engine in an advertisement is one of a limited number of predictable options available for forms of advertisement displays. The Examiner understands that this combining does not modify or alter the combining of Whitman, Kapur, and Crane as above.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the refined search queries of Whitman with the demographic filtering of Kapur, the ticker and XML presentation of Chane, and the search engine advertisement of Croy in order to include a search window in the advertisement.

The rationale for combining in this manner is that including a search engine in an advertisement is one of a limited number of predictable options available for forms of advertisement displays.

13. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, it meets the claim. See *e.g. In*

re Collier, 158 USPQ 266, 267 (CCPA 1968) (where the court interpreted the claimed phrase “a connector member for engaging shield means” and held that the shield means was not a positive element of the claim since “[t]here is no positive inclusion of ‘shield means’ in what is apparently intended to be a claim to structure consisting of a combination of elements” and where the court interpreted the claimed phrase “said ferrule-forming member being crimpable onto said shield means” and held that the shield means was not a positive element of the claim since “[t]here is no positive inclusion of ‘shield means’ in what is apparently intended to be a claim to structure consisting of a combination of elements.... “[t]he ferrule or connector member is crimpable but not required, structurally, to be crimped These cannot be regarded as structural limitations and therefore not as positive limitations in a claim directed to structure. They cannot therefore be relied on to distinguish from the prior art.”).

The Examiner has analyzed the claim language and phrasing as indicated by the **bold** sections or words above, and determined that the phrasing following the **bolded** word(s) is not required due to the terminology being optional or intended use or expected results, in conformity with MPEP § 2111.04.

Response to Arguments

14. Applicant's arguments filed January 4, 2011 have been fully considered but they are not persuasive.

Applicant first argues that the "means for" language of claim 45 indicates a computer or computing device. The Examiner notes, however, that the claim is drawn to a system where the first element is a computing device; therefore, if one accepts Applicants argument, the claim consists of a computing device comprising a computer or computing device – which does not make sense. The functions are apparently intended to be performed by some aspect of a computer or computing device, and as indicated in the rejection above, the means for is also indicated in Applicant's specification to include software, applications, web pages, the internet, a document, and/or a type of file. Applicant is reminded that MPEP § 2114 indicates that an apparatus such as the claimed system may be described structurally or functionally, but the distinction must be structural for the apparatus to be patentably distinct – and as claimed herein, the "means for" does not define a difference that can be defined. Therefore the Examiner is not persuaded that there is a limitation defined by the specification upon which the "means for" language can rely.

Applicant's arguments with respect to the prior art have been considered but are moot in view of the new ground(s) of rejection and therefore not persuasive.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SCOTT D. GARTLAND whose telephone number is

571-270-5501. The examiner can normally be reached on 7:30-6:00 EST Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SCOTT D GARTLAND/
Examiner, Art Unit 3622